The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. PALLESEN,
VILAS M. ATHAVALE and SRIDHAR GUNAPU

Appeal No. 2005-0611
Application No. 09/521,005

ON BRIEF

Before BARRETT, LEVY and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-12, 14-24, and 26-36.

Claims 13 and 25 have been canceled.

Invention

Appellants' invention relates to a product rate calculation system and method. The product rate calculation system including a database interface, a product rate information cache, an expression evaluation routine, and a client interface. The database interface is operable to request and receive product rate information from a database, the product rate information including at least one product rate expression. The product rate information cache stores product rate information. The expression evaluation routine is operable to parse a product rate expression stored in the product rate information cache into at least one token, and is also operable to evaluate the at least one token to determine a product rate. The client interface is operable to provide the product rate to a client application running on a computer system. Appellants' specification at page 3, lines 6-15.

Claim 15 is representative of the claimed invention and is reproduced as follows:

15. A method of calculating a product rate comprising:

loading product rate information including at least one product rate expression from a database;

storing the product rate information in a cache;

receiving a request for a product rate from a client application running on a computer system;

parsing the at least one product rate expression stored in the cache into at least one token;

evaluating the at least one token to determine the product rate; and

transmitting the product rate to the client application running on the computer system.

References

The references relied on by the Examiner are as follows:

Dworkin	4,992,940	Feb. 12, 1991
Bosco et al (Bosco)	5,191,522	Mar. 2, 1993
Kennedy	5,787,453	Jul. 28, 1998

Rejections At Issue

Claims 1-6, 8-9, 11-12, 14-18, 20-24, 26-30, and 32-36 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Dworkin and Kennedy.

Claims 7, 10, 19, and 31 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Dworkin, Kennedy, and Bosco.

Throughout our opinion, we make references to the Appellants' brief, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 1-12, 14-24, and 26-36 under 35 U.S.C. § 103.

[1] Appellants filed an appeal brief on May 14, 2004. The Examiner mailed an Examiner's Answer on July 27, 2004.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)]. Appellants have indicated that for purposes of this appeal the claims stand or fall together. See page 3 of the brief. We will, thereby, consider Appellants' claims as standing or falling together, and we will treat claim 15 as the representative claim of the group.

I. Whether the Rejection of Claims 1-12, 14-24, and 26-36 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-12, 14-24, and 26-36. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with

evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 15, Appellants argue at page 6 of the brief, "Dworkin neither teaches nor suggests the purported 'expression' identified by the Examiner." To determine whether claim 15 is obvious over the references, we must first determine the scope of the claim. Appellants' specification shows a method at figure 3 for calculating a product rate. Appellant argues that "expression" should be narrowly defined as "an expression that when evaluated yields a product rate" (brief at page 5). Note that Appellants' figure 3 shows processing an expression at steps 330-350, and Appellants' specification at page 10, line 29, through page 11, line 2, shows that product rate information is typically "a logical and/or algebraic expression." Examples of such expressions are found at page 12 of the specification.

Our reviewing court states in **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that

they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Sys. Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), **cert. denied**, 538 U.S. 1058 (2003).

Upon our review of Appellants' specification, we find that Appellants have defined the term "expression" to be limited to a logical and/or algebraic expression. We note that the Examiner has likewise interpreted the claim as requiring a logical and/or algebraic expression. See the bottom of page 4 of the final office action (Paper number 15). However, contrary to the Examiner's position, we do not find that Dworkin must perform a calculation using such an expression. Rather, the only rate determination process discussed specifically in Dworkin uses a lookup table to attain a calculation result rather than performing the calculation. The Examiner has not addressed this difference. See Dworkin at column 8, lines 38-55, with particular attention to lines 51-52.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Other Issues

We draw the Examiner's attention to Appellants' specification at page 2, lines 5-7. It appears that Appellants are admitting that the use of insurance product rate expressions is known in the prior art. If this should prove to be the case, then a rejection over this art in view of Kennedy may be appropriate. We leave it to the Examiner to request information from Appellants so as to fully develop this issue (See 37 CFR § 1.105).

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-12, 14-24, and 26-36.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

ALLEN R. MACDONALD
Administrative Patent Judge

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